



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09,838,730	04/19/2001	Tawfik R. Arabi	884.410US1	9492

7590

03/31/2003

Schwegman, Lundberg, Woessner & Kluth, P.A.
P.O. Box 2938
Minneapolis, MN 55402

EXAMINER

ROBERT, RUSSELL MARC

ART UNIT	PAPER NUMBER
----------	--------------

2829

DATE MAILED: 03/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/838,730

Applicant(s)

ARABI ET AL.

Examiner

Russell M Kobert

Art Unit

2829

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 31-47 is/are pending in the application.
- 4a) Of the above claim(s) 31-42 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-9 is/are allowed.
- 6) ☒ Claim(s) 1-5 and 43-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

1. Applicant's election **without traverse** of Invention I, Species 1, claims 1-9, in Paper No. 3 is acknowledged. It is noted that newly added claims 31-47 are presented in the Amendment filed on January 16, 2003. Applicants assert that the newly added claims read on the elected species. The Examiner respectfully disagrees. Newly added claims 31-42 are directed to a separate Invention than that which has been elected. However, newly added claims 43-47 meet the criteria of the election noted supra. For purposes of examination, the election will be maintained as an election without traverse. In summary, Invention I, Species 1, claims 1-9 and 43-47 are elected **without traverse**.
2. Claims 31-42 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Invention and/or Species, there being no allowable generic or linking claim. Election was made **without traverse** in Paper No. 3.
3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. A good example of such a title, although not necessarily related to this specific case, could be "*Method and Apparatus for Passive Optical Characterization of Semiconductor Substrates Subjected to High Energy (MEV) Ion Implantation Using High-Injection Surface Photovoltage.*"
4. The abstract of the disclosure is objected to because it does not contain narrative form in the range of 50 to 150 words. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-5 and 43-47 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Miyagawa (5523699).

7. Claims 1-5 and 43-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Consiglio (5519327).

Consiglio anticipates a method of testing an integrated circuit (IC), the method comprising: driving a terminal on the IC to a state (col 6, ln 64 – col 7, ln 3); stopping the driving of the terminal (col 6, ln 4-9); floating the terminal for a predetermined time (T_2); and determining a state of the terminal after the predetermined time (col 7, ln 59 – col 8, ln 4); as recited in claim 1.

As to claim 2, determining quality of the IC based on the state of the terminal after the predetermined time (considered inherent to Consiglio; see Abstract). Moreover the limitations of claims 3-5 are considered the inherent method of use of Consiglio.

Consiglio anticipates a machine-readable medium having instructions stored thereon to cause a tester to perform a method, the method comprising: driving a terminal on the IC to a state (col 6, ln 64 – col 7, ln 3); stopping the driving of the terminal (col 6, ln 4-9); floating the terminal for a predetermined time (T_2); and determining a state of the terminal after the predetermined time (col 7, ln 59 – col 8, ln 4); as recited in claim 43.

As to claims 44-47, the limitations are considered the inherent method of use of Consiglio.

8. The following is a statement of reasons for the indication of allowable subject matter:

A method of testing comprising: charging a pin on an integrated circuit (IC) until it reaches a known state; stopping the charging of the pin; floating the pin for a predetermined time; sampling a state of the pin after the predetermined time; and determining a test result of the pin based on the state of the pin after the predetermined time, wherein the method is performed with Boundary Scan as recited in claim 6 has not been found.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hashimoto (6255842) and Ferguson et al (6342790) show various methods of measuring current response from a device under test to determine a condition of the device under test.

10. A shortened statutory period for response to this action is set to expire three month(s) from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell Kobert whose telephone number is (703) 308-5222.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Russell M. Kobert
Patent Examiner
Group Art Unit 2829
March 11, 2003



KAMAND CUNEO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800